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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,333	04/06/2001	Syed K. Quraishi	62225-160	2977
<div>7590 04/27/2010 MCDERMOTT, WILL &amp; EMERY 600 13th Street, N.W. Washington, DC 20005-3096</div>				
<div>EXAMINER CHENCINSKI, SIEGFRIED E</div>				
<div>ART UNIT 3695</div>		<div>PAPER NUMBER</div>		
<div>MAIL DATE 04/27/2010</div>		<div>DELIVERY MODE PAPER</div>		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/827,333

**Applicant(s)**

QURAIISHI ET AL.

**Examiner**

SIEGFRIED E. CHENCINSKI

**Art Unit**

3695

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-13 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO-834/05)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Status of Application*

1. a) Claims 6-13 and 29-40 are pending.
- b) The letter appointing Mr. Babak Akhlaghi, L0250, to represent Applicant on matters of this application is accepted because it satisfies Patent Rule 11.9,
- c) Applicant has amended claims 6, 12 and 37.

### **Applicant Admitted Prior Art**

2. Applicant has admitted that the items for which the examiner took Official Notice in rejecting dependent claims 7 -13 in the last Office Action were prior art at the time of Applicant's invention. Accordingly these items are now Applicant Admitted Prior Art (hereafter AAPA). MPEP 2104 C 2nd parag. - AAPA - Applic. Admission due to lack of or inadequate Travelsal:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

These AAPA features are:

**Re. Claim 7**, in which the assigned scope of application level specifies a specific account.

**Re. Claim 8**, in which the assigned scope of application specifies a specific registered representative.

**Re. Claim 9**, in which the assigned scope of application is level specifies a specific office.

**Re. Claim 10**, in which the assigned scope of application level specifies a specific firm.

**Re. Claim 11**, in which the assigned scope of application is set to the global level.

**Re. Claim 12**, in which a rule is accompanied by a message to be sent when a rule is violated.

**Re. Claim 13**, in which the text of said message can be changed by a user for a selected level.

### ***Claim Rejections - 35 USC § 101***

**3. System claims 6-13 and 29-40 are rejected** because the claimed invention is not supported by either a clearly asserted utility or a well established utility because the claimed invention is drawn to an interface which is software. Therefore, the claims are inoperative and hence lack utility.

Independent claims 6 and 31 are not patentable subject matter. Dependent claims 7-13, 29, 30 and 32-40 are rejected because of their dependence on rejected claims 6 and 31.

Software is not patentable subject matter. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. (MPEP 2106.01, I).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**4. Claims 6-13 and 29-40 are also rejected under 35 U.S.C. 112, first paragraph**

Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**5. Claims 6-13 and 29-40 are under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Re. the independent claims, it is unclear what the processing section does because this limitation is full of intended use language (e.g. claims 6 and 31,

"a) an interface for receiving a plurality of transactions, each transaction containing a request either (1) for an order to be sent to a market for execution or (2) for execution of an asset transfer from an account; and

b) a storage medium having rules stored thereon for determining whether or not to allow execution of a requested order or asset transfer, the rules having parameters for analysis of the requested order or asset transfer and a plurality of preset levels of scope of application".

Most of the language in the limitations is found after the word "for", making the claims intended use statements. All of the limitations of independent claims 6 and 31 are similarly dominated by intended use.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3695

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejections under 35 USC 101 and 112 above have introduced a significant degree of ambiguity regarding the understanding of Applicant's current claims. The prior art rejections which follow are therefore the examiner's best attempt at examination in view of the prior art.

**6. Claims 6 and 31 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Stein et al. (US Patent 5,978,779, hereafter Stein) in view of AAPA.

**Re. Claims 6 & 31**, Stein discloses a system and program storage medium for processing a transaction containing an order for execution.

Stein further discloses a system and program storage medium, with the system of claim 6 as exemplary, comprising the steps of:

- a) an interface (implicit in Fig. 4).
- b) a storage medium having rules stored thereon (Fig. 4 - 409), and
- c) an order/transaction processing section having access to the storage medium (Fig. 5 and Fig. 4),

The difference in independent claim 31 compared to independent claim 6 is that "each rule has an assigned outcome selected from a plurality of preset outcomes". However, given the large use of preset rules in Stein as documented above, the ordinary practitioner of the art would have found it obvious to have also established preset outcomes in the rules.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein combined with AAPA and the practitioner's own knowledge to produce Applicant's invention of a system and program storage medium for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

7. **Claims 7-13 and 32-38 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Stein as applied to claim 6 above, and further in views of AAPA.

**Re. Claims 7-13**, Stein does not explicitly disclose:

**Re. Claim 7**, in which the assigned level of scope of application of an applied rule specifies a specific account.

**Re. Claim 8**, in which the assigned level of scope of application of an applied rule specifies a specific registered representative.

**Re. Claim 9**, in which the assigned level of scope of application of an applied rule specifies a specific office.

**Re. Claim 10**, in which the assigned level of scope of application of an applied rule specifies a specific firm.

**Re. Claim 11**, in which the assigned level of scope of application of an applied rule is set to the global level.

**Re. Claim 12**, in which an applied rule is accompanied by a message to be sent when a rule is violated.

**Re. Claim 13**, in which the text of said message can be changed by a user for a selected level.

However, AAPA discloses claims 7-13. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claims 32-36**, Stein does not explicitly disclose:

**Re. Claim 32**, in which the assigned level of scope of application of an applied rule specifies a specific account.

**Re. Claim 33**, in which the assigned level of scope of application of an applied rule specifies a specific registered representative.

**Re. Claim 34**, in which the assigned level of scope of application of an applied rule specifies a specific office.

**Re. Claim 35**, in which the assigned level of scope of application of an applied rule specifies a specific firm.

**Re. Claim 36**, in which the assigned level of scope of application of an applied rule is set to the global level.

However, AAPA discloses claims 32-36. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 37, neither Stein nor AAPA explicitly disclose** an applied rule accompanied by a message to be sent when an applied rule is violated. However, it would have made common sense to the ordinary practitioner based on well established practices to send a message to one or more affected parties that a rule has been violated and informing the parties of the rule which has been violated. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 38**, in which the text of said message can be changed by a user for a selected level (Col. 6, ll. 2-5; the user makes changes to information as a revision. This suggests to the ordinary practitioner that user changes can be made to various messages documents in the system).



**8. Claims 29 & 30 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Stein as applied to claim 6 above, and further in view of Lutnick et al. (US Patent 6,850,907 B2, hereafter Lutnick).

**Re. Claims 29 & 39**, Stein discloses wherein upon the application of at least one of the rules to a third transaction: the order/transaction processing section forwards the requested order or asset transfer contained in the third received transaction to an execution process for fulfillment (See the rejection of claim 6 above).

Stein does not explicitly disclose the sending of a warning message regarding a requested transaction. However, Lutnick discloses sending a warning message regarding a requested transaction (Col. 5, l. 2).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and Lutnick combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 30 & 40**, the disclosures of Stein are cited above. Stein does not explicitly disclose stopping execution of a transaction request. However, Lutnick discloses rules automatically stopping the execution transaction requests by participants (Col. 32, l. 55). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and Lutnick combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

***Response to Arguments***

9. Applicant's arguments filed December 23, 2009 with respect to claims 6-13 and 29-40 have been considered but they are moot in view of the new grounds of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

AZIZ ET AL. US Patent 6,018,721

SEUBERT ET AL. US Pg Pub. 2008/0120129

SANDHU ET AL. US Pg Pub. 2003/0033212

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*

or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

Art Unit 3695

April 24, 2010

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 3695